

REMARKS

After entry of the here-enclosed amendment: Claims 1, 3, 5, 16, 21, 23, 30, 31, 33, 35, 36, 37, 38, 40, 41 and 42 are amended; Claims 1-42 are pending; and, Claims 43-45 are canceled.

In response to the Examiner' s objection under 37 CFR § 1.77(b), Applicant has inserted headings in the application, “if applicable” (emphasis added). It should be noted that headings are only required if applicable, under 37 CFR § 1.77(c). Accordingly, it is respectfully requested that this objection be withdrawn.

In response to the Examiner' s rejection for nonstatutory double patenting, Applicant is submitting herewith a terminal disclaimer with reference to commonly owned U.S. Patent No. 6,941,728. It is respectfully requested that this rejection be withdrawn.

In response to the Examiner' s objection under 37 CFR § 1.75, Applicant has amended Claim 30 to delete the phrase “wherein the pack is a hinged lid side-by-side vertically hinged cigarette pack”, which phrase was inadvertently included in Claim 30 despite the fact that it had been deleted in the International Phase of the corresponding PCT application by a PCT Article 34 amendment. Claim 40 therefore no longer duplicates language in Claim 30, and it is respectfully requested that this objection be withdrawn.

In response to the Examiner' s rejection of Claims 16 and 42 under 35 USC § 112, Applicant has amended the dependencies of those claims as was most helpfully suggested by the Examiner. It is respectfully requested that this rejection be withdrawn.

The Examiner has rejected independent Claims 1, 30 and 41 under 35 USC § 102(b) and dependent Claims 2-29, 31-40 and 42 under 35 USC § 103(a), all in view of *Boriani et al.* *Boriani et al.* is directed to a method of producing fully enclosed cartons of cigarettes containing multiple packets of cigarettes. The packets of cigarettes are clearly individual cigarette packs as we understand them in the U.S., which fully enclose the cigarettes and are individually openable by means of a lid (see packets 4 in Fig. 3).

In contrast, the embodiments of Applicant' s invention include both method steps and apparatus for producing a unique cigarette pack which can be swung open to reveal two separate bundles of cigarettes connected by a hinge. The two bundles of cigarettes in Applicant' s embodiments are not fully enclosed by a surrounding carton, but are partially surrounded by an outer blank member which forms at least part of the outer surface of the pack when the pack is closed.

Both the method and apparatus claims have been amended to clarify the partial enclosing of the two bundles of cigarettes by the outer blank member.

Additional claims are drawn to such features which further define over *Boriani et al.* such as the cutting of the outer blank member along the bottom wall thereof to allow the pack to be swung open; providing a vertical hinge panel on the outer blank member which is adhesively applied to the first assembled cigarette bundle to allow the pack to be swung open; and providing two bundles of cigarettes for the pack which contain differing numbers of cigarettes.

It is submitted that the *Boriani et al.* reference does not even remotely direct itself, nor does it teach, suggest or motivate one to form the unique pack of cigarettes as accomplished by the method and apparatus embodiments of the invention. The Examiner' s assertions that Applicant' s method and apparatus are drawn to old and well known features is, it is respectfully submitted, traversed by the fact that *Boriani et al.* is not drawn to any method or apparatus for producing any pack of cigarettes having the features of Applicant' s unique pack, nor has the Examiner cited any other reference that does.

For the reasons set forth above, it is submitted that the application is now in condition for allowance, and such action is respectfully requested.

The Examiner is requested to telephone the undersigned attorney if anything further is required.

Respectfully submitted,

/Charles I. Sherman/

APPARATUS AND METHOD FOR PACKING SMOKING ARTICLES

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